

Section II. (REMARKS)

The claims pending herein are 1, 2, 4-7, 10, 14, 15, 17-21, 53-57 and 59.

Allowable Subject Matter

In the February 24, 2009 Office Action, the Examiner objected to claim 57, indicating that it would be allowable if rewritten in independent form. Applicants acknowledge same.

Request for Rejoinder Reminder

Applicants respectfully request rejoinder of method claims 24-31, 33-35, 39, 43-50, and 58 upon allowance of the pending composition claims 1-2, 4-7, 10, 14, 15, 17-21, 53-57, and 59.¹

Rejection of Claims and Traversal Thereof

In the February 24, 2009 Office Action:

claims 1-2, 4-5, 10, 15, 19-20 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Koito et al. (U.S. Patent Application Publication No. 20030130147) (hereinafter Koito) in view of En et al. (U.S. Patent Application Publication No. 20040134682) (hereinafter En) and Sato et al. (U.S. Patent No. 5,849,467) (hereinafter Sato).

This rejection is traversed and reconsideration of the patentability of the pending claims is requested in light of the following remarks.

According to the Examiner:

“Koito et al. do [sic] not specify an alkali base. However, it is known in the art at the time the invention was made to obtain and use an alkali base for the advantage of providing a sufficient alkalinity and stripping power. Evidence can be seen in at least En et al. . . . or in Sato et al. . . .” (see, the February 24, 2009 Office Action, page 3, lines 15-21)

According to the Examiner, it would be obvious to include “potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power.”

It is well established that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Koito recites:

“[h]owever, it was found that if the components to elevate stripping functions were excessively added, and the pH of the stripping composition was 6 or below, or 12 or above, a certain type of low-dielectric films were damaged.” (see, Koito, paragraph [0016])

One skilled in the art considering Koito would not be motivated to provide “additional alkalinity” (per the Examiner’s exact words) to the Koito stripping compositions because Koito actually recites that pH values greater than 12 are detrimental to low-[k] dielectric films. In other words, the modification proposed by the Examiner, whereby strong alkali bases such as KOH are added to the Koito stripping composition, would render Koito unsatisfactory for its intended purpose because the pH would likely be greater than 12 and low-k dielectric materials would be damaged. Accordingly, one skilled in the art would have no reason to proceed in the direction the Examiner has proposed.

Withdrawal of the rejection of claims 1-2, 4-5, 10, 15, 19-20 and 56 in view of Koito, En and Sato is respectfully requested.

Provisional Double Patenting Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

In the February 24, 2009 Office Action, the Examiner provisionally rejected claims 1, 4-6, 10, 15, 17-21, 53 and 56 under the judicially created doctrine of obviousness-type double patenting. Specifically, the Examiner stated that said claims are:

“unpatentable over claims 4-5, 12-17, 33-36, 39, 42-47 as amended on 01/10/08 [sic] of co-pending application No. 10/389,214 (and its teachings and suggestions in the specification on at least paragraphs 9, 12, 13, 17, 18, 21, 23, Examples 2, 4 and 5). However, applicants,

¹ Rejoinder was previously requested in the response to the April 18, 2005 Office Action, filed April 27, 2005.

assignee and their counsel may and should disagree, urge and state on and for the record that each of the claims as originally filed is self sufficient. There has not been and will not be relied on any embodiment and any application for any purpose) considered in view of En et al (2004/0134682)." (see the February 24, 2009 Office Action, page 4).

Applicants acknowledge same.

When the obviousness-type double patenting rejection is the only rejection remaining in the presently pending case AND the presently pending claims are an obvious variation of the invention defined in U.S. Patent Application No. 10/389,214 (which can only be objectively assessed when the only rejection remaining in the presently pending case is the obviousness-type double patenting rejection), applicants will assess whether to submit a terminal disclaimer.

Conclusion

Claims 1, 2, 4-7, 10, 14, 15, 17-21, 53-57 and 59 are in form and condition for allowance. Authorization is hereby given to charge any deficiency in applicable fees for this response to Deposit Account No. 13-4365 of Moore & Van Allen PLLC. If any additional issues remain, the Examiner is requested to contact the undersigned attorney at (919) 286-8090 to discuss same.

Respectfully submitted,

MOORE & VAN ALLEN PLLC



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By: _____

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